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FACSIMILE TRANSMITTAL FORM	Application Number	10/790898
	Confirmation Number	2585
	Filing Date	March 1, 2004
	First Named Inventor	Williams, Todd R.
	Examiner Name	Catherine A. Simone
Fax: 571-273-8300	Attorney Docket Number	56523US009
Total Number of Pages in This Submission: 10 (Including cover)		
Date: December 5, 2006	Attorney for Applicant: Stephen W. Buckingham/mms	

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Case No.: 56523US009

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor: WILLIAMS, TODD R.
Application No.: 10/790898 Confirmation No.: 2585
Filed: March 1, 2004 Group Art Unit: 1772
Title: DIMENSIONALLY STABLE COMPOSITE ARTICLE
Examiner: CATHERINE A. SIMONE

REPLY BRIEF

Mail Stop: Appeal Brief-Patents
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December 5, 2006

Date

Signed by: Madonna Schroeder

Dear Sir:

This is a reply to the Examiner's answer mailed October 5, 2006.

☒ Please charge the fee provided in 37 CFR § 41.20(b)(2) to Deposit Account No.

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No. 13-3723.

Appellants hereby waive any personal appearance before the Board of Appeals to argue the issues of this appeal.

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STATUS OF CLAIMS

Claims 1 through 26 are pending. Claims 1 through 26 stand rejected. Claims 1 through 26 are appealed.

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GROUND OF REJECTION TO BE REVIEWED ON APPEAL

First Ground of Rejection

Claims 1 through 11 and 13 through 22 stand rejected under 35 USC § 102(b) as purportedly anticipated by any one of U.S. Patents No. 5,468,540 ("Lu").

Second Ground of Rejection

Claims 12 and 23 through 26 stand rejected under 35 USC § 103(a) as purportedly unpatentable over the teachings of the Lu patent.

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ARGUMENT

The subject application was finally rejected by the Examiner in an action dated May 19, 2006. The applicants appealed the final rejection filing the Brief on Appeal on August 31, 2006. The Examiner's Answer was mailed on October 5, 2006. This Reply Brief is filed to comment briefly on the points made in the Examiner's Answer. As noted above, the applicants have waived any personal appearance for oral argument of this appeal.

Rejection Under 35 U.S.C. §102(b)

In the Examiner's Answer the Examiner continues to assert that the Lu patent teaches an article having "large scale predictable dimensional stability" without explaining where she finds that teaching or even providing a definition of the phrase. Without knowing how the Examiner is using the term, it is impossible to know if the Lu patent teaches that property under her definition. However, the proper standard is whether the Lu patent teaches that property as defined in the present specification and it clearly does not.

In support of her contention that the Lu patent teaches the invention as claimed the Examiner merely states that "[T]he radiation cured polymer taught in Lu consists of a curable oligomeric composition" and then asserts that therefore it "inherently has a large scale predictable stability." She provides no support for the statement that such a broad class of materials all have this property as it is defined in the present specification.

The Examiner seizes on an unfortunate typographical error in the applicant's Brief on Appeal and says that the property "long term predictable dimensional stability" does not appear in the claim. While this is true, other parts of the Brief on Appeal correctly argue the limitation "large scale predictable dimensional stability" is not met by the Lu patent. What is more important is the fact that claims use the phrase "large scale predictable dimensional stability" and that is the term defined in the specification. It is not taught by the Lu reference.

Finally, the Examiner asserts that the phrase in question is given no patentable weight because it appears in the preamble and a limitation in the preamble "is not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure." However, in this case the recitation in the preamble defines more than the intended use of the article being claimed, it defines what the article actually is. This clearly gives "life,

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meaning and vitality to the claim." Actually the present situation is quite similar to the example provided in the Manual of Patent Examining Procedure in which the Court of Customs and Patent Appeals gave patentable weight to the phrase "an abrasive article" in a preamble to note that the claimed article was a coated abrasive. *MPEP* 2111.02. In the present claims, the case is even more clear since the phrase in question is specifically defined in the specification.

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Rejection Under 35 U.S.C. §103(a)

For the reasons stated above, the invention as defined by the present claims is not anticipated by the Lu reference. There is nothing in the Lu reference that would lead one of skill in the art to produce a article having large scale predictable dimensional stability and the Examiner has not even alleged that to be the case. Clearly the present invention is not obvious in view of this reference.

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CONCLUSION

For the foregoing reasons, the Examiner has erred in rejecting this application. The appellants respectfully request that the Board of Patent Appeals and Interferences reverse the Examiner on all counts.

Respectfully submitted,

December 5, 2006
Date

By:

[Signature]
Stephen W. Buckingham, Reg. No.: 30,035
Telephone No.: 651-733-3379

Office of Intellectual Property Counsel
3M Innovative Properties Company
Facsimile No.: 651-736-3833

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EVIDENCE APPENDIX

None.

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RELATED PROCEEDINGS APPENDIX

None.